

AMENDMENT
In re Application of Hans Bauer

P-45 MG

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This Amendment is a second response to the Office Action mailed May 2, 2005. The Examiner's comments in that Action have been carefully considered.

No new matter has been added.

Applicants request entry of this amendment in the record.

No fees are believed due for this submission, as it follows a previously made timely submission. However, authorization is provided to access Deposit Account no. 10-0100 should any additional fees be due beyond those enclosed herein, or to credit any overpayments.

Applicants thank Examiner Yao for his efforts and time in reviewing this matter. Following a number of substantive conferences it was agreed that the previously proposed main claim (new claim 19) is allowable. The dependent claims, claims 20-27, are allowable as they depend from an allowable base claim.

Applicants also note that during our conference, Applicants challenged the assertion that "it is old in the art to adhesively bond a pair of materials where one of the materials is placed on a support member which has a recess for receiving an adhesive." (See Office Action page 5, last para). It was agreed that no art had been located to date to support this particular limitation in the claims, or that if art had been located its combination with EP'915 was inappropriate.

During our conference the following items were identified as requiring additional comment from Applicants:

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(a) A general review the basis of support for the amendments:

As is well known, support is drawn from all aspects of the disclosure, including the claims, drawings, and spec, including those earlier claim amendments that have been accepted by the Office. For example, see specification page 5, first paragraph where not only specific types of adhesives are disclosed, they are disclosed in the context of the phrase *"the invention is not limited....other known adhesive substances can also be employed, such as....."* This phrase broadly encompasses all types of KNOWN ADHESIVE SUBSTANCES and is not limited in any material way by the examples. Thus, the adhesive in claim 19 may be any known elastomeric adhesive substance.

(b) The use of the phrase "at least one" or "at least partially filled" in the claims (see claim 19).

Applicants respectfully note that when interpreting claim language, the Applicants may be their own lexicographer as long as the meaning given to the term is not repugnant to the term's well known usage. MPEP § 2173.01, 2111.01, MPEP §21783.05(a) and *In re Prater*, 415 F.2d 1393 and elsewhere.

The words in the claims must be given their plain meaning MPEP §2111.01, thus a claim requiring "a first layer" is subsumed within the phrase "at least a first layer" which of course also includes "a first layer". There is no limitation within the phrase "a first layer" to the use of only one layer – this is an interpretation of language missing from the claim. The claim language includes "a first layer" but may include many more

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layers as long as there is "a first layer" thus, the phrase "at least a first layer" is equivalent drafting and well within Applicants' control as a lexicographer. It is noted that the Examiner must "*bear in mind that, especially in non-chemical cases, the words in a claim are not limited to their meaning by what is shown or disclosed in the specification.*" MPEP 2111.01 (Page 2100-477).

Additionally, the use of the phrase "at least partially filled" is to be similarly interpreted as being fully disclosed and supported by the application. The disclosure includes a step of filling, and therefore subsumes and teaches the beginning, middle, and end of the filling process. There is no limitation to the step of "filling" that mandates a completion of such a process as long as the step includes the initial filling clearly described by at "least partially filling." Any requirement that a "filling" be to a top of such a cavity would be to read limitations into a claim – a practice strictly prohibited.

(c) Regarding the support for the Markush group in new claim 26. We have provided a revision of claim 26 above we propose responds to the Examiners concerns, additionally:

- (i) Claim 10 introduced the adhesive substance (the elastomeric adhesive substance from claim 17) as an elastomeric silicone adhesive structured as a single-component adhesive substance.
- (ii) Claim 11 introduced the elastomeric silicone adhesive structured as a multi-component adhesive substance.
- (iii) Claim 12 introduces polyurethane adhesive substances.
- (iv) Claim 13 introduces unvulcanized rubber adhesives.

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- (v) The initial specification, as noted above, supports the use of "other known elastomeric adhesives" (specification page 5, top para.).

Thus, it is easily supported that claim26, as provided herein, has broad support for it's limitations and formulations.

Should the Examiner's initial comments remain of concern, Applicants would suggest a risk exists that the Examiner is interpreting claim language according to a meaning not dictated by the rather broad initial disclosure. If the Examiner maintains a claim language interpretation not dictated by the broad total disclosure, Applicants respectfully request an offer of proof that the claim language dictated by the specification is some how repugnant to the well known usage.

In conclusion, Applicants respectfully propose that the above comments and discussion are sufficient to address the points raised by the Examiner during our teleconference.

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BEST AVAILABLE COPY**SUMMARY**

In view of the foregoing, it is believed that the method as now defined in the claims of record, clearly and patentably distinguishes over the applied art. Reconsideration of the prior art rejections and withdrawal of same is, therefore, respectfully requested.

The application is believed to be in condition for allowance and issuance. Early notice and processing to that affect is respectfully solicited.

Should the Examiner have remaining questions, he is directed to conference with the below-signed counsel (Myron Greenspan) at cell phone 917-701-6578 at his convenience over the following weekend.

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By 
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Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100.